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EXAMINER

LE, UYEN CHAU N

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 05/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/466,144

Applicant(s)

PATHMASUNTHARAN ET AL.

Examiner

Uyen-Chau N. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 60-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 60-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Prelim. Amdt/Amendment

1. Receipt is acknowledged of the Election/Amendment filed 08 January 2003. Claims 1-12 and 60-69 are currently pending in the application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5 and 7-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Cyras et al (US 5,889,866).

Re claims 1-5 and 7-8: Cyras et al discloses an IC/smart card 34 comprising a connector 32, which serves as an interface for interfacing with a computer system, which serves as an IC/smart card reader; first circuitry configured to receive a first enable signal from a smart card enabler (i.e., prompting the user to enter his/her password 48/52); and a second circuitry coupled with the interface 32 and the first circuitry and configured to allow the smart card 34 to function with the smart card reader based on the first enable signal (i.e., receiving and verifying the entered password), wherein the first circuitry is also configured to receive a second enable signal from the smart card enabler (i.e., enable signal 50/whether the entered password is valid),

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wherein the second circuitry is also configured to allow the smart card to perform a transaction with the smart card reader based on the second enable signal (i.e., performing the smart card operation), wherein the first enable signal and the second enable signal are radio frequency signals (col. 6, lines 29+), wherein the second circuitry is also configured to disable the smart card 34 to function/perform the transaction with the smart card reader if the first circuitry does not receive the second enable signal (col. 8, lines 23+), wherein the second circuitry performs the transaction with the smart card reader through the interface 32 after receiving the first enable signal and the second enable signal (figs. 1-5; col. 6, line 5 through col. 8, line 33).

4. Claims 1, 9-12, 60-64 and 67-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Dethloff (US 6,047,888).

Re claims 1, 9-12, 60-64 and 67-69, Dethloff discloses a data medium/chip card 20 comprising a first interface 29 (i.e., via line 12) for communicating with a smart card enabler; a second interface 29 (i.e., via line 16) for communicating with a smart card reader; a memory resource [25, 26] to store an identification key, a transaction key and a transaction value (fig. 6; col. 14, line 61 through col. 15, line 32); a control/processing unit 21 to send the identification key (secret number) to the smart card reader through the first interface 12; send the transaction key to the smart card enabler through the first interface as a consequence of the smart card receiving a first enable signal from the smart card enabler, wherein the first enable signal sent in response to the sending of the identification key/secret number; send the transaction value (i.e., the amount of money to be transferred) to the smart card reader through the second interface in order to entertain a transaction, wherein the transaction value being sent as a consequence of the smart card receiving a second enable signal from the card enabler, wherein the second enable

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signal in response to the sending of the transaction key 33 (figs. 2-7; col. 10 line 42 through col. 11, line 48; col. 11, lines 49+ and col. 13, line 42 through col. 14, line 31 and col. 15, line 33 through col. 16, line 3), wherein the second interface further comprises a contact interface [42, 44], wherein the first interface further comprises an antenna loop 46, which serves as an RF interface (fig. 8; col. 16, lines 4+), wherein the chip/smart card 20 further comprises an I/O interface 29 coupled to the control/processing unit 21 (figs. 1 & 8; col. 9, lines 60+ and col. 16, lines 4+), wherein the chip/smart card 20 further configured to create and store a new transaction key as a consequence of a new transaction value having been received from the card reader, the new transaction key stored into the memory resource, and send new transaction key and the new transaction value to the smart card enabler (figs 1-7; col. 9, line 60 through col. 17, line 23).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cyras et al in view of Schick et al (US 5,180,902). The teachings of Cyras et al have been discussed above.

Re claim 6, Cyras et al further discloses with the capability of disabling the smart card to from functioning after the third attempt of invalid password (col. 9, lines 21+), but fails to teach or fairly suggest that the smart card is disabled to perform the transaction after a predetermined time period.

Schick et al teaches the card is disabled within a specific time period (col. 2, lines 60+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Schick et al into the teachings of Cyras et al in order to provide Cyras et al with a more secure system to prevent the identification number/password being manipulated by an unauthorized user/operator. Furthermore, such modification would have been an obvious extension as taught by Cyras et al, and therefore an obvious expedient.

8. Claims 65-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dethloff in view of Nakano (US 4,692,601). The teachings of Dethloff have been discussed above.

Re claims 65-66, Dethloff has been discussed above but fails to teach or fairly suggest that the smart card I/O interface further comprises a key pad/a display.

Nakano teaches a smart card 1 having a key pad 2 and a display 3 (figs. 1-7; col. 2, lines 40+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Nakano into the teachings of Dethloff in order to provide Dethloff with a more user friendly system wherein the user have a capability of entering data via a keypad and viewing the output data via a display which being disposed directly on the card, and thus providing the user a flexibility of checking his/her transaction/balance at anytime anywhere. Furthermore, such modification would have been an obvious extension as taught by Dethloff, and therefore an obvious expedient.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Atsumi et al (US 5,034,597); Pavlov et al (US 4,614,861); Yap et al (US 6,111,506) are cited as of interest and illustrate a similar structure to a system and method for using a smart card.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on SUN, M, W, F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Ull
Uyen - Chau Ngo Le

April 28, 2003

Diane I. Lee
DIANE I. LEE
PRIMARY EXAMINER